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10/666,631	09/18/2003	Robert Birch	1160215/0514436	9238

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EXAMINER	
GRAHAM, CLEMENT B	
ART UNIT	PAPER NUMBER
3691	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/666,631	BIRCH ET AL.	
	Examiner	Art Unit	
	Clement B. Graham	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/27/10*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20, are pending in this Application.

Claims Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine et al (Hereinafter Haseltine U.S Patent 5, 578, 015) in view Oulo et al (Hereinafter Oulo U.S Patent 6, 792, 460.

As per claim 1, 5, Haseltine discloses a computerized method for billing for services comprising the steps of:

creating a descriptor file designating a pre-defined element (i. e, "payment cycle") storing said descriptor file in a tangible computer readable medium (see column 3 lines 1-30 and column 11 lines 31-46) configuring a handler resident on a computer comprising a processor operable to execute computer readable instructions to monitor a service network communication, between a service requestor ("i. e, customer") and a service provider ("i. e, biller") for said predefined element in said descriptor file (see column 3 lines 1-30 and column 11 lines 31-46). configuring

said handler to send said pre-defined element to a set of programmed instructions to create an event record, electronically transmitting said event record to a billing system for further processing (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46) wherein the handler configured to monitor for said predefined element in said descriptor file is located at an entity taken from the list of entities consisting of, (a) the service requestor; and (b) the service provider (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

Haseltine fails to explicitly teach web services and to monitor web service and wherein the set of programmed instructions is configured to copy the pre-defined element from the network communication into the event record.

However Oulo discloses a set of components and data structures that may be used to record execution start and stop times when instrumented methods are executed as part of monitored transactions, and report these execution times, in raw and/or aggregated form, to an outside entity. It should be understood that the three processes illustrated in FIG. 6 (instrumentation, execution time monitoring, and reporting) typically occur at different times. Specifically, instrumentation occurs when a class is loaded into the Java or other virtual machine (see column 12 lines 8-25 and column 15 lines 21-34 and column 7 lines 38-52).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify the teachings of Haseltine to include web services and to monitor web service and wherein the set of programmed instructions is configured to copy the pre-defined element from the network communication into the event record taught by Oulo in order to

monitor the amount of time spent by specific application components, such as Java components, during execution of specific transactions on a web site or other server system.

Haseltine explicitly teaches a bill report processor. Examiner notes that the fact that these elements that were discussed in a previous interview such as ("configuring a handler resident on a computer comprising a processor operable to execute" computer readable instructions to monitor a web service network communication" and programmed instructions is configured to copy the predefined element" and to intercept said communication") are capable of performing specific functions does not mean that they actually perform the functions as recited in the claims. The functions recited in the claim are not positive limitations but only requires the elements to be able to perform the functions. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

As per claim 2, Haseltine discloses wherein said programmed instructions are configured to determine whether an event corresponding to said event record requires authorization (see column 3 lines 1-67 and column 4 lines 1-3, 53-67 and column and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 3, Haseltine discloses a computerized method as wherein said programmed instructions are configured to determine whether an event corresponding to said event record

requires rating (see column 3 lines 1-67 and column 4 lines 1-3, 53-67 and column and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 4, Haseltine discloses further comprising: transforming said pre-defined element according to a set of instructions in said descriptor file before transmitting said event record to the billing system (see column 3 lines 1-67 and column 4 lines 1-3, 53-67 and column and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 6, Haseltine discloses wherein said billing system comprises programmed billing instructions coded to determine whether a service transaction may be performed (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 7, Haseltine discloses wherein said programmed billing instructions are configured to determine if said service requestor is permitted to access said web service transaction (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 8, Haseltine discloses wherein said billing system returns a response to said web service provider indicating whether said web service transaction should proceed (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per 9, Haseltine discloses wherein said programmed billing instructions are configured to determine whether said service requestor is solvent enough to purchase said service transaction (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 10, Haseltine discloses wherein said programmed billing instructions are configured to return a response to a set of application code associated with said web service provider indicating whether said web service transaction should proceed (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 11, Haseltine discloses wherein said programmed billing instructions are configured to return a response to said web service provider indicating a quantity for said service transaction to proceed (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 12, Haseltine discloses wherein said service network communication comprises a SOAP message stream; wherein the service requestor accesses the service provider on a direct peer-to-peer basis; and wherein the handler is located at the service provider (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 13, Haseltine discloses wherein said SOAP message stream comprises a set of data including quality of service information authorization key fields version numbers, encrypted

account information, and start/stop time (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 14, Haseltine discloses wherein said billing system uses said pre-defined element in said SOAP message stream to support at least one pre-defined billing plan (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 15, Haseltine discloses wherein said pre-defined billing plans is chosen from a list consisting of subscriptions, bundled plans, time-based usage plans, re-occurring charges, one-time charges, discount plans based on usage, discount plans based on time-of-day, discount plans based on customer loyalty, discount plans based on family/organization relationships, tiered plans, location dependent pricing, and combinations thereof (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 16, Haseltine discloses a tangible computer readable medium having computer executable instructions for performing a method comprising:
receiving a descriptor file designating at least one pre-defined element (i. e, "payment cycle") and utilizing said descriptor file to monitor a network communication for said pre-defined element(s) and electronically sending said record to a billing system for further processing (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

Haseltine fails to explicitly teach web service and copying said-predefined element(s) from said network communication into a record.

However Oulo discloses a set of components and data structures that may be used to record execution start and stop times when instrumented methods are executed as part of monitored transactions, and report these execution times, in raw and/or aggregated form, to an outside entity. It should be understood that the three processes illustrated in FIG. 6 (instrumentation, execution time monitoring, and reporting) typically occur at different times. Specifically, instrumentation occurs when a class is loaded into the Java or other virtual machine (see column 12 lines 8-25 and column 15 lines 21-34 and column 7 lines 38-52).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify the teachings of Haseltine to include web service and copying said-predefined element(s) from said network communication into a record taught by Oulo in order to monitor the amount of time spent by specific application components, such as Java components, during execution of specific transactions on a web site or other server system.

Haseltine explicitly teach a bill report processor. Examiner notes that the fact that these elements that were discussed in a previous interview such as ("Utilizing said descriptor file to monitor web service ") are capable of performing specific functions does not mean that they actually perform the functions as recited in the claims. The functions recited in the claim are not positive limitations but only requires the elements to be able to perform the functions. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

As per claim 17, Haseltine discloses a system for billing comprising:

a descriptor file, a handler a record wherein said descriptor file designates at least one pre-defined elements(i. e, "payment cycle") said handler is configured to monitor a web service network communication, between a service requestor and a service provider (see column 3 lines 1-30 and column 11 lines 31-46) and to intercept said communication if said communication corresponds to said at least one pre- defined element in said descriptor file said handler is further and a billing system and said handler is further configured to electronically transmit said record to a billing system for further processing (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

Haseltine fails to explicitly teach web services and configured to copy said pre-defined elements from said network communication into a record.

However Oulo discloses a set of components and data structures that may be used to record execution start and stop times when instrumented methods are executed as part of monitored transactions, and report these execution times, in raw and/or aggregated form, to an outside entity. It should be understood that the three processes illustrated in FIG. 6 (instrumentation, execution time monitoring, and reporting) typically occur at different times. Specifically, instrumentation occurs when a class is loaded into the Java or other virtual machine (see column 12 lines 8-25 and column 15 lines 21-34 and column 7 lines 38-52).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify the teachings of Haseltine to include web services and configured to copy said pre-defined elements from said network communication into a record taught by Oulo in

order to monitor the amount of time spent by specific application components, such as Java components, during execution of specific transactions on a web site or other server system.

Haseltine explicitly teach a bill report processor. Examiner notes that the fact that these elements that were discussed in a previous interview such as ("and to intercept communication" "configured to copy said predefined elements and configured to electronically transmit said record") are capable of performing specific functions does not mean that they actually perform the functions as recited in the claims. The functions recited in the claim are not positive limitations but only requires the elements to be able to perform the functions. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

As per claim 18, Haseltine discloses wherein said billing system is embedded within a web service server; wherein said further processing comprises determining whether said service requestor is solvent enough to purchase a web service corresponding to said web service network communication and wherein said web service network communication comprises a SOAP message stream; wherein said handler is located at the service provider and wherein the service requestor accesses the service provider on a direct peer-to-peer basis (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 19, Haseltine discloses wherein the monitored web service network communication is between a service requestor and a service provider, and wherein the computer readable medium is located at the service provider (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

As per claim 20, Haseltine discloses wherein the web service network communication comprises a communication where the service requestor accesses the service provider on a direct peer-to-peer basis (see column 3 lines 1-67 and column 11 lines 31-46 and column 12 lines 27-46).

Conclusion

RESPONSE TO ARGUMENTS

4. Applicant's arguments filed 11/27/10 has been fully considered but they are moot in view of new grounds of rejection.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CG

March 24, 2011

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691